

Application No. 09/833,151
Attorney Docket No. 00/8026
Customer No. 32,127

REMARKS

This amendment is responsive to the final Office Action¹ mailed February 8, 2005. Claims 1-11 and 16-37 were presented for examination and were rejected. Applicant proposes to amend claims 1, 6, 9, 16, 19, 22, 27, 31, and 35. No claims are added. Thus claims 1-11 and 16-37 would be pending upon entry of this amendment. No new matter has been added.

In the Office Action the Examiner rejected the following claims under 35 U.S.C. § 103(a): claims 1-3, 5, 22-26, and 35-37 as unpatentable over U.S. Patent No. 6,034,621 to Kaufman ("Kaufman") in view of U.S. Publication No. US 2003/0023759 to Littleton et al. ("Littleton") and further in view of U.S. Patent No. 6,820,204 to Desai et al. ("Desai"); claim 4 as unpatentable over Kaufman in view of Littleton, further in view of Desai, and further in view of U.S. Patent No. 6,643,669 to Novak et al. ("Novak"); claims 6, 7, 9, 10, 16, 17, 19, 20, and 27-34 as unpatentable over Littleton in view of U.S. Publication No. US 2001/0044321 to Ausems et al. ("Ausems") and U.S. Publication No. US 2002/0111156 to Roeder ("Roeder"); claims 8, 11, 18, and 21 as unpatentable over Littleton in view of Ausems, and further in view of Kaufman.

By this amendment, Applicant proposes to amend claims 1, 6, 9, 16, 19, 22, 27, 31, and 35. Support for these amendments can be found throughout the specification,

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action. As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to certain requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references) is not a concession by Applicant that such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

Application No. 09/833,151
Attorney Docket No. 00/8026
Customer No. 32,127

for example, at pages 21-22, ¶ 051. Applicant respectfully traverses the Examiner's rejections of the claims under 35 U.S.C. § 103(a), based on the following.

To establish a *prima facie* case of obviousness under §103(a), three basic criteria must be met. First, the prior art reference as modified must teach or suggest all the claim elements. (See M.P.E.P. § 2143.03 (8th ed. 2001)). Second, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. (See M.P.E.P. § 2143 (8th ed. 2001)). Third a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." (M.P.E.P. § 2143.03 (8th ed. 2001)).

§ 103(a) Rejection of Claims 1- 5, 22-26, and 35-37

The Examiner rejected claims 1-3, 5, 22-26, and 35-37 as unpatentable over Kaufman in view of Littleton and further in view of Desai. The Examiner also rejected claim 4 as unpatentable over Kaufman in view of Littleton, further in view of Desai, and further in view of Novak. Applicant begins with a discussion of claim 1.

Claim 1 recites a combination including:

a voice communication module for establishing a voice communication link between the wireless telephone and a second telephone; and

a memory, comprising:

a synchronization routine, wherein the synchronization routine is downloaded from a remote server if the synchronization routine is not present in the wireless telephone; and

a database;

Application No. 09/833,151
Attorney Docket No. 00/8026
Customer No. 32,127

said synchronization routine being adapted to automatically transmit information reflecting a database change to a computer over a wireless network while the voice communication link is established.

None of the cited references teach or suggest the combination recited by claim 1. For example, none of the cited references describe a "synchronization routine being adapted to automatically transmit information reflecting a database change to a computer over a wireless network while the voice communication link is established." Although Kaufman describes a "wireless remote synchronization of data between PC and PDA" that provides for "simplified, discrete and automated synchronization of calendar and contact-related data between a personal computer and a remote personal digital assistant" (Kaufman col. 1, lines 1-12), this does not constitute a teaching of "said synchronization routine being adapted to automatically transmit information reflecting a database change to a computer over a wireless network while the voice communication link is established." While Kaufman describes a personal digital assistant containing a synchronization routine, Kaufman does not teach or suggest that "said synchronization routine" is "adapted to automatically transmit information reflecting a database change to a computer over a wireless network while the voice communication link is established."

Likewise, although Littleton describes a "system and method for provisioning telephony services via a personal digital assistant" that provides for "synchronization of information between a wireless portable device and a server" (Littleton, title, ¶ 0002), Littleton fails to teach or suggest a "synchronization routine being adapted to automatically transmit information reflecting a database change to a computer over a wireless network while the voice communication link is established."

Application No. 09/833,151
Attorney Docket No. 00/8026
Customer No. 32,127

Regarding Desai, although Desai describes a "system and method for selective information exchange" that provides "control over the content of stored information, as well as control over the access to the stored information" (Desai, col. 3, lines 35-38), Desai also fails to teach or suggest "said synchronization routine being adapted to automatically transmit information reflecting a database change to a computer over a wireless network while the voice communication link is established." Therefore, Kaufman, Littleton, or Desai, taken either alone or in any legally permitted combination, fail to teach a wireless telephone having "said synchronization routine being adapted to automatically transmit information reflecting a database change to a computer over a wireless network while the voice communication link is established," as recited in claim 1.

Since the cited references fail to teach all of the elements of claim 1, no prima facie case of obviousness has been made out. For at least the foregoing reasons, Applicant submits that claim 1 is allowable over Kaufman, Littleton and/or Desai, and therefore respectfully requests withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a). Because claims 22 and 35 are independent claims which include limitations similar to those discussed above with respect to claim 1, Applicant further submits that claims 22 and 35 are also allowable over Kaufman, Littleton and/or Desai for at least the reasons given with respect to claim 1, and respectfully requests that the Examiner withdraw the rejections of claims 22 and 35 as well.

Moreover, Applicant submits that dependent claims 2-5, 23-26, and 36-37 are allowable, not only for the reasons stated above with regard to their respective allowable base claims, but also for their own additional features that distinguish them

Application No. 09/833,151
Attorney Docket No. 00/8026
Customer No. 32,127

from the cited references.² Accordingly, Applicant requests withdrawal of the rejection of claims 2-5, 23-26, and 36-37 under 35 U.S.C. § 103(a) and the timely allowance of these pending claims.

§ 103(a) Rejection of Claims 6, 7, 9, 10, 16, 17, 19, 20, and 27-34

The Examiner rejected claims 6, 7, 9, 10, 16, 17, 19, 20, and 27-34 as unpatentable over Littleton in view of Ausems and further in view of Roeder. Applicant begins with a discussion of claim 27.

Claim 27 recites a computer-implemented method that includes:

establishing a voice communication link between the wireless telephone and a second telephone;

initiating a synchronization routine to transmit the data file from the wireless telephone to the computer over the wireless network; and

receiving the data file by the computer,

wherein the voice communication link remains established during the initiating and the receiving.

None of the cited references teach or suggest the method recited by claim 27. For example, none of the cited references teach or suggest "establishing a voice communication link between the wireless telephone and a second telephone . . . wherein the voice communication link remains established during the initiating and the receiving," as recited in claim 27.

² As Applicant's remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejections of all claims dependent therefrom, Applicant's silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicant to the Examiner's assertions as to these claims, and Applicant reserves the right to analyze and dispute such assertions in the future.

Application No. 09/833,151
Attorney Docket No. 00/8026
Customer No. 32,127

in the Office Action, the Examiner admitted that Littleton does not provide a teaching of "establishing a voice communication link between the wireless telephone and a second telephone." (Office Action, p. 10.) Littleton likewise does not describe "establishing a voice communication link between the wireless telephone and a second telephone . . . wherein the voice communication link remains established during the initiating and the receiving," as recited in claim 27.

The Examiner further relied on the description in Ausems, asserting that Ausems describes a "personal digital assistant this is [a] wireless telephone." (Office Action, p. 4-5.) However, Ausems does not teach or suggest "establishing a voice communication link between the wireless telephone and a second telephone . . . wherein the voice communication link remains established during the initiating and the receiving," as recited in claim 27.

The Examiner further relied on Roeder in the Office Action as describing "establishing a voice communication link between the wireless telephone and a second telephone." (Office Action, pg. 10). Roeder describes a system and method for "call transferring in a communication system" (Roeder, Title) that provides for "call transferring in a communication system [which] includes a first client operable to communicate with a mobile station... [and] a second client operable to communicate with a first telephonic device and with the first client, and a third client operable to communicate with a second telephonic device and with the first and second clients." (Roeder ¶ 10.) However, Roeder fails to teach or suggest "establishing a voice communication link between the wireless telephone and a second telephone . . .

Application No. 09/833,151
Attorney Docket No. 00/8026
Customer No. 32,127

wherein the voice communication link remains established during the initiating and the receiving," as recited in claim 27.

Since the cited references fail to teach all of the elements of claim 27, no *prima facie* case of obviousness has been made out. For at least the foregoing reasons, Applicant submits that claim 27 is allowable over Littleton in view of Ausems and further in view of Roeder, and requests withdrawal of the rejection of claim 27 under 35 U.S.C. § 103(a). Because claims 6, 9, 16, 19, and 31 are independent claims which include limitations similar to those discussed above with respect to claim 27, Applicant further submits that claims 6, 9, 16, 19, and 31 are also allowable over Littleton in view of Ausems and further in view of Roeder, for at least the reasons given with respect to claim 27, and respectfully requests that the Examiner withdraw the rejections of claims 6, 9, 16, 19 and 31 as well.

Moreover, Applicant submits that dependent claims 7, 8, 10, 11, 17, 18, 20, 21, 28-30, and 32-34 are allowable not only for the reasons stated above with regard to their respective allowable base claims, but also for their own additional features that distinguish them from the cited references. Accordingly, Applicant requests withdrawal of the rejection of claims 7, 8, 10, 11, 17, 18, 20, 21, 28-30, and 32-34 under 35 U.S.C. § 103(a) and the timely allowance of these pending claims.

Application No. 09/833,151
Attorney Docket No. 00/8026
Customer No. 32,127

Conclusion

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-11 and 16-37 in condition for allowance.

Applicant submits that the proposed amendments of claims 1-11 and 16-37 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined, for example, in claims 6-8, 9-11, 19-21, 27-30, and 31-34. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented both a new reference and new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Application No. 09/833,151
Attorney Docket No. 00/8026
Customer No. 32,127

Please grant any extensions of time required to enter this response and charge
any additional required fees to deposit account no. 07-2347.

Respectfully submitted,

VERIZON CORPORATE SERVICES
GROUP INC.

Date: May 9, 2005

By: 
Joseph R. Palmieri
Reg. No. 40,760

Verizon Corporate Services Group Inc.
600 Hidden Ridge Drive
Mail Code: HQE03H14
Irving, Texas 75038
972-718-4800
CUSTOMER NO. 32127